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OCT 06 2005

OFFICE OF PETITIONS

In re Application of:
Thrift et al.
Application No. 08/419,229
Filed: April 10, 1995
Docket No.: TI-20205

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This is a decision on the renewed petition under 37 C.F.R. § 1.59 to expunge almost all the information contained in the Notice of Allowability issued by the Patent and Trademark Office (hereafter "PTO") on March 23, 2004.

The petition is **denied**.

BACKGROUND

This application was the subject of Federal Circuit review, in which the Court affirmed the decision of the Board of Patent Appeals and Interferences with respect to claims 1-10, and vacated and remanded the Board's decision with respect to claims 11-19. See In re Thrift, 298 F.3d 1357, 63 USPQ2d 2002 (Fed. Cir. 2002).

The Board then remanded this application to the examiner, noting that since applicants' claims 11-19 were drafted in means-plus-function format, they must have corresponding specification structure pursuant to 35 U.S.C. § 112, ¶ 6 and In re Donaldson, 16 F.3d 1189, 1194-95, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (en banc). After discussing Donaldson, the Board's remand decision stated:

The Examiner must therefore *determine* the precise scope of the appealed claims consistent with 35 U.S.C. § 112, sixth paragraph, and must consider how the art of record, as well as any newly discovered prior art, may be applicable to the determination of the patentability of *properly construed* claims 11-19.

Remand Order at 3-4 (emphasis added).

Upon remand from the Board, and *in view of applicants' specification*, the examiner then issued a non-final rejection under 35 U.S.C. § 112, ¶ 1 (lack of enablement) and ¶ 2 (indefiniteness). Specifically, the examiner found applicants' specification lacking with regard to reciting corresponding structure. Therefore, the examiner did not reach (*i.e.*, address) 35 U.S.C. § 112, ¶ 6, per the Board's Order.

In view of (applicant-initiated) telephonic interviews, the Technology Center re-considered applicants' specification and allowed the pending claims on December 30, 2003, without however, expressly addressing applicants' specification and the Board's Order. Applicants paid the issue fee on March 1, 2004.

On March 23, 2004, the PTO issued a Notice of Allowability (hereafter "PTO Notice"), stating near the beginning:

After a final review of the record of the application prior to issue, it was determined that the record was incomplete vis-a-vis the Board of Patent Appeals and Interferences' directive to determine the scope of the means-plus-function language cited in the remand and to provide an analysis as to the patentability of the thus-construed claims in light of the prior art. See Paper number 24, 'REMAND TO THE EXAMINER,' paragraph bridging pages three and four, citing In re Donaldson Co., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc).

The PTO Notice then determined applicants' specification structure corresponding to applicants' chosen means limitations, pursuant to 35 U.S.C. § 112, ¶ 6, In re Donaldson, and the Board's Order. See, e.g., Means for extracting corresponds to specification figure 2, web browser 52.

On May 4, 2004, applicants filed an "Objection to Communication from Examiner . . ." and a Petition to Expunge the PTO Notice. The Objection paper was considered to be applicants' comments under 37 C.F.R. § 1.104(e), *infra*.

The Petition to Expunge was dismissed on February 17, 2005.

The instant request for reconsideration was filed on April 5, 2005.

STATUTE AND REGULATIONS

35 U.S.C. § 112, ¶ 6 states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

37 C.F.R. § 1.104(e) states in pertinent part:

Reasons for allowance. If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner.

The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner.

37 C.F.R. § 1.59(b) states in pertinent part:

Any petition to expunge information from an application must . . . establish to the satisfaction of the Director that the expungement of the information is appropriate.

OPINION

I. The PTO Notice, generally reciting from applicants' specification (*already part of the administrative record*), was properly made part of the administrative record

A. Applicants' claims and the prosecution history required issuance of the PTO Notice (versus possible later expungement)

With respect to claims 11-19, the Federal Circuit remanded this case to the Board with specific instructions prohibiting reliance on common knowledge. Consistent with the Federal Circuit's opinion, the Board then remanded the case to the examiner with specific instructions concerning 35 U.S.C. § 112, ¶ 6 (concerning applicants' chosen means limitations) and In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc) (PTO required to construe means-plus-function language by "look[ing] to the specification and interpret[ing] that language in light of the corresponding structure"). Claim 11 is exemplary of this claim set and reads (emphasis added):

A voice activated Hypermedia system using grammatical metadata, said system comprising:

- a. a speech user agent;
- b. a network browsing module;
- c. an information resource located on a computer network wherein said speech user agent facilitates voice activation of said network browsing module to access said information resource;
- d. a means for extracting a grammar from a hypermedia source on said information resource for future reference to said source;
- e. a means for modifying said grammar;
- f. a means for automatically producing an intelligent grammar from said information resource; and
- g. a means for processing said grammar to produce a reference to said hypermedia source.

As to *all the various means-limitations* applicants' have chosen to employ in their claims, the Board specifically ordered the examiner "as part of the review of this application . . . [to] determine the precise scope of the appealed claims consistent with 35 U.S.C. § 112, sixth paragraph" Remand Order at 3-4. Significantly, the Board discussed Donaldson and how the statute expressly requires that applicant-chosen means limitations "shall be construed to cover the corresponding structure . . . described in the specification and equivalents thereof," 35 U.S.C. § 112, ¶ 6. Since the PTO must act in writing, 37 C.F.R. § 1.2, the examiner ultimately understood the foregoing directive as requiring an express determination of the structures in the specification corresponding to applicants' "means" limitations. The examiner merely followed the Board's Order, in view of the statute and Donaldson, by issuing the PTO Notice, *which simply recited the relevant parts of applicants' specification, already of record in this application.*

In issuing the PTO Notice, the examiner merely complied with the Board's Order, as 37 C.F.R. § 1.104(e) also supports. Specifically, PTO Rule 104(e) states in pertinent part:

If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims . . . or be the subject of a separate communication to the applicant.

Since other claims were not being rejected at this point, the examiner properly issued "a separate communication to the applicant." *Id.* Also, because there was genuine debate between the examiner and applicants on how § 112 applied to this case (September-December 2003), it was reasonable for the examiner to clarify the record in writing thereafter. As a matter of fact, applicants even utilized the next part of the rule by filing a statement commenting on the PTO Notice, *i.e.*, their "Objection" paper. Each page of this submission states that it is a "Reply to Office communication of March 23, 2004 [*i.e.*, the PTO Notice]." Their submission was considered by the examiner, but did not result in a change in the PTO Notice. Accordingly, both the examiner and the applicants relied on PTO Rule 104(e) in this situation.

- B. 37 C.F.R. § 1.104(e) authorizes the PTO to clarify the record "at any point" prior to patent issuance, as held by Leeds v. Commissioner of Patents

As long as the PTO has power over a case, Rule 104(e) permits it to clarify the record. See Blacklight v. Rogan, 295 F.3d 1269, 63 USPQ2d 1534 (Fed. Cir. 2002) (even after an applicant pays an issue fee, the PTO has the authority to withdraw the application from issue and enter a rejection on the merits). Surely, clarifying the the record without withdrawal from issue etc., as was done in this case, is something short of withdrawing from issue to enter a rejection, as the Federal Circuit in Blacklight wholly permitted.

As to timing, "[i]f the patent examiner decides that a patent application should be granted, he must ensure that the patent file, the record detailing the prosecution history of the issued patent, is as complete as reasonably possible, and that the reasons why the patent application is allowed are evident from the file record. See Manual of Patent Examining Procedure § 1302.14." Leeds v. Comm'r of Patents and Trademarks, 955 F.2d 757, 759, 21 USPQ2d 1771, 1772 (D.C. Cir. 1992) (emphasis added). As the Leeds Court further held, "[i]f the examiner determines at any point that the record does not make clear his reasons for allowing the patent, he may, pursuant to [the rule], write up and put in the file a separate statement of reasons." Leeds, 955 F.2d at 759, 21 USPQ2d at 1772 (emphasis added). Also, "as the Manual suggests, most [of these] statements are made at the end of the process when the patent is about to issue . . . [whose] function is essentially supplementary, to fill in gaps or holes in the file record." *Id.*, 955 F.2d at 762, 21 USPQ2d at 1774 (emphasis added). Thus, clarifying or completing the record is important and in the public's interest when the record is less than complete, as was once the case here.

Moreover, in Blacklight, the Federal Circuit further held that "[t]he complexity of the examination process" necessitates "according the PTO latitude" to fulfill its "obligation to assure that patents are properly examined." *Id.* at 1273, 63 USPQ2d at 1537. Certainly, this latitude further buttresses the examiner's authority to clarify the record pursuant to the Board's Order, 35 U.S.C. § 112, ¶ 6 and Donaldson. See 37 C.F.R. § 1.104(e).

As explained in the PTO dismissal decision of February 17, 2005, which is incorporated herein by reference, it is incumbent upon every examiner in exercising his or her responsibility to the

public to see that the file history is as complete as reasonably possible. See MPEP § 1302.14. It is likewise USPTO policy, per the foregoing MPEP section, that when an application is allowed after a remand from the Board, a statement of reasons for allowance be added to the record. MPEP § 1302.14 Example (D). Indeed, that section of the MPEP also sets forth another example of when it is likely that a statement of reasons for allowance should be added to the record, i.e., subsequent to, as here, a decision by the Federal Circuit. MPEP § 1302.14 Example (H). Thus, the examiner was clearly following applicable authorities and the history of this case in issuing the PTO Notice.

Put simply, the Federal Circuit remanded this case for claims 11-19 to be re-considered and the Board, in light of those claims, further remanded the case to the examiner for it to be analyzed pursuant to 35 U.S.C. § 112, ¶ 6. That is exactly what the examiner did in the PTO Notice. Applicants were free to respond to it, as they have done. Applicants are not, however, unilaterally able to preclude this analysis or have it expunged from the file, infra. It is the examiner's rationale, and thus proper, and must be made part of the file.

II. Expungement of information is only appropriate in rare situations and should not be used to delete from the prosecution history a properly-issued paper on the specification

"Any petition to expunge information from an application must . . . establish to the satisfaction of the Director that the expungement of the information is appropriate." 37 C.F.R. § 1.59(b). The MPEP makes clear that the expungement of record information should occur in very limited situations. See MPEP § 724.05. That particular section of the MPEP and referenced-section 724.02, along with MPEP § 714.25, address the following types of information as subject (or susceptible) to possible expungement:

- 1) trade secret information;
- 2) proprietary information;
- 3) protective order material;
- 4) unintentionally-submitted information;
- 5) information submitted in a wrong application; and
- 6) discourteous/lack of decorum information.

The above situations are the only known types of circumstances which have led to PTO-information expungement. Clearly none of them applies here. Applicants have not alleged that the information includes any trade secret, is proprietary in nature or is subject to a protective order. Neither was the information wrongly-submitted. Nor was it discourteous or lacking in decorum.

Rather, the PTO Notice merely recites the parts of applicants' specification which correspond by law (35 U.S.C. § 112, ¶ 6) to applicants' chosen means limitations. The specification does not contain any of the above type of information and is expected to publicly issue with current claims 11-19 in a patent in the future. Thus, specification information is merely repeated in the PTO Notice, per the statute etc. See Above section I. Accordingly, no recognized basis for expunging information applies to this case and the PTO sees no reason to exercise its discretion to deviate from, or expand upon, the above-established bases for expungement. See, e.g., Saxbe v. Bustos, 419 U.S. 65, 74 (1974) (acknowledging an agency's right to maintain a "longstanding administrative construction"). Moreover, where, as set forth above, the PTO Notice was properly issued, its elimination from the prosecution history would be inappropriate. Finally, expungement typically concerns a line or a relatively-small section of a paper, see, e.g., above types 1-3, as opposed to applicants' request herein of essentially the

elimination of a whole paper (and corresponding ones) from a soon-to-be patented file, which the public has a right to see under 37 C.F.R. § 1.11(a).

While applicants may disagree with the contents of the contested communication, the PTO has long held that a mere difference in opinion does not warrant expungement of the corresponding information contained in an application paper. See, e.g., Ex Parte Fox, 1910 Dec. Comm'r Pat. 123 (Comm'r Pat. 1910).

III. Applicants have made limited arguments to the PTO, each of which has been considered but is not persuasive

Applicants have made the following specific arguments to the PTO:

- 1) the examiner did not have authority to issue the PTO Notice (Petition at 3-4, 5-7);
- 2) prosecution being closed barred issuance of the PTO Notice (Petition at 4-5); and
- 3) the examiner violated MPEP § 1302.14 (Petition at 7-8).

However, contrary to applicants' first argument, above section I shows that the examiner had full and express authority to issue the PTO Notice. In sum, the examiner followed the Board's Remand Order, 35 U.S.C. § 112, ¶ 6, and In re Donaldson (en banc) in addressing applicants' specification language to clarify the record.

As to applicants' second argument, it is well-settled that the PTO "retain[s] jurisdiction in the prosecution of applications and correcting what it considers to be mistakes in its decisions, until the time for judicial review has expired or a patent has issued." In re Borkowski, 505 F.2d 713, 718, 184 USPQ 29, 32-33 (CCPA 1974) (emphasis added). See also Blacklight, 295 F.3d at 1273, 63 USPQ2d at 1537; In re Bass, 314 F.3d 575, 577, 65 USPQ2d 1156, 1157 (Fed. Cir. 2002) (until a reexam certificate issues, "the PTO may reconsider an earlier action") (citing Borkowski); Harley v. Lehman, 981 F.Supp. 9, 11, 44 USPQ2d 1699, 1701 (D.D.C. 1997). As thoroughly discussed above, the Leeds Court expressly held:

If the examiner determines at any point that the record does not make clear his reasons for allowing the patent, he may, pursuant to [the rule], write up and put in the file a separate statement of reasons. . . . as the Manual suggests, most [of these] statements are made at the end of the process when the patent is about to issue . . . [whose] function is essentially supplementary, to fill in gaps or holes in the file record.

955 F.2d at 759, 762, 21 USPQ2d at 1772, 1774 (emphases added). Thus, *the time* at which the examiner exercised his authority, established in above section I, was of no consequence in view of the foregoing authorities.

As to their third and final argument, applicants expressly rely on the following passage found in MPEP § 1302.14:

Where specific reasons are recorded by the examiner, care must be taken to ensure that statements of reasons for allowance (or indication of allowable subject matter) are **accurate, precise, and do not place unwarranted interpretations, whether broad or narrow, upon the claims.**

(Emphasis added by applicants). After quoting the above passage, applicants state, in a conclusory manner, the PTO Notice statements are "not accurate, not precise and they place unwarranted interpretations upon the claims." Petition at 7-8. However, applicants have not shown the PTO Notice to lack accuracy/precision. Rather, the notice followed the Board's Remand Order and applicants' specification, in view of applicants' chosen means limitations. As to any warranted interpretations upon the claims, 35 U.S.C. § 112, ¶ 6 and Donaldson, 16 F.3d 1189, 29 USPQ2d 1845, actually place an interpretation upon a claim *when an applicant chooses to employ means claims*. The examiner merely applied these binding authorities to clarify the record. Moreover, it is well-settled that as to patent-enforcement, "the statement of an examiner [on allowance] will not necessarily limit a claim." ACCO Brands v. Micro Sec. Devices, 346 F.3d 1075, 1079, 68 USPQ2d 1526, 1529 (Fed. Cir. 2003). Thus, this particular argument made by applicants is not persuasive.

As set forth above, the arguments applicants made to the PTO have been fully considered and are expressly addressed in this decision.

DECISION

For the reasons given above and in the decision mailed February 17, 2005, applicants have not established to the satisfaction of the Director that expungement of the contested material is appropriate within the meaning of 37 C.F.R. § 1.59(b). Accordingly, the petition is **denied**.

This decision may be considered final agency action. See MPEP § 1002.02.



Charles Pearson
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